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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,807	07/15/2003	Joseph Sellars	2296.03US02	7668

24113 7590 10/18/2005

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EXAMINER

WALCZAK, DAVID J

ART UNIT PAPER NUMBER

3751

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/619,807		SELLARS, JOSEPH	
	<b>Examiner</b>		<b>Art Unit</b>	
	David J. Walczak		3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7, 11, 13 and 18 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10, 12, 14-17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 5, 6, 8, 14, 15, 16, 17, 19, 20 and 21 remain rejected under 35 U.S.C. 102(e) as being anticipated by Hsu. In regard to claims 1, 4, 14, 15 and 21, Hsu discloses a sales promotional writing apparatus comprised of a writing member having a body 6 defining a longitudinal axis and an attachment member 4 in transverse orientation to the axis wherein the body includes a lumen to receive a ball-point pen cartridge 5 and the attachment member includes a cavity 45 in an attachment surface and a locking member 46 and a display member 1 having a display surface and an insertion member 3 attached to the display member wherein the insertion member has a receiving member 31 thereon adapted to receive the locking member. In regard to claims 5, 6, 16 and 17, the display surface 1 defines an "advertisement" for the writing instrument itself. In regard to claims 8, 19 and 20, the locking member and receiving member are considered to both "permanently" attach the writing member and the display member (i.e., there is a secure attachment therebetween) and removably attach

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the writing member and the display member (i.e., upon disassembly of the device, the display member can be removed).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 9, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu in view of Ho. In regard to claims 2 and 3, although the Hsu device does not disclose a base member for the writing apparatus, attention is directed to the Ho reference, which discloses a base member 1 for a writing apparatus P (Figure 4) wherein the base member includes a base surface 3 and a mounting surface 24 wherein the mounting surface includes a mounting bore 27 oriented at an angle to a plane defined by the base surface and wherein the base surface includes means 34 for fixedly attaching the base member to a surface. It is here noted that the statements of intended use, i.e., "to a sales counter" does not lend any patentable structure to claims. Further, the base surface 3 is clearly capable of being mounted to a sale counter should a user so decide to employ the device. Such a device is used for conveniently storing writing implements when not in use. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ such a base member to store the Hsu device in order to enable a user to conveniently store the

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device when not in use. In regard to claims 9, 10 and 12, the claimed method is inherent in the usage of the device discussed supra. Further, although the Ho reference does not specifically disclose that the base member can be mounted to a sales counter, the Ho reference does disclose that the wall can be on any suitable location (column 1, lines 25-26). Accordingly, surface W can obviously be a "sales counter" since sales counters have vertical walls therebelow which can be used to hold the Ho device.

### ***Allowable Subject Matter***

Claims 7, 11, 13 and 18 are allowed.

### ***Response to Arguments***

Applicant's arguments filed 10/7/05 have been fully considered but they are not persuasive. The Applicant contends that the Hsu reference is not applicable against claims 1 and 14 since this reference does not disclose an insertion member having a receiving member which receives a locking member of the cavity. As discussed in detail above, however, the Hsu reference clearly discloses an insertion member 3 having a "receiving member" 31 which "receives" a locking member 46 of cavity 45. As Webster defines "receive" as "bear", and member 31 bears on channel (i.e., "locking member") 46, member 31 can be referred to as a "receiving member". The Applicant further contends that the locking mechanism 43, 44 "merely holds the two half torsos in place", however, this argument is not understood as the Examiner has not relied on elements 43, 44 to teach the claimed invention. Element 46 is used to teach the

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"locking member" as this element (channel) secures member 31 (even though member 31 is movable within the channel, the channel still "locks" member 31 in that member 31 cannot be readily removed from the device. The Applicant further contends that the Hsu reference does not anticipate claim 21, however, the Applicant has not specifically pointed out which of the claimed elements are not taught by Hsu. Accordingly, claim 21 stands rejected as discussed above. Regarding claims 2, 3, 9, 10 and 12, the Applicant further contends that there is no suggestion to combine the Hsu and Ho references. In response to this argument, however, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art, after reviewing the Hsu and Ho references, would readily recognize that the writing implement disclosed by Hsu can be held in the writing implement holder disclosed by Ho. The Applicant lastly contends that Hsu in view of Miller are not applicable against the claims. This argument is also not understood as no such rejection has been made.

### ***Conclusion***

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the

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grounds and art of record in the next Office action if they had been entered in the earlier application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Walczak  
Primary Examiner  
Art Unit 3751

DJW  
10/14/05